



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,297	06/19/2001	Lonnie O'Neal Ingram	BCI-024CP	2679

959 7590 07/02/2002

LAHIVE & COCKFIELD  
28 STATE STREET  
BOSTON, MA 02109

EXAMINER

RAO, MANJUNATH N

ART UNIT	PAPER NUMBER
----------	--------------

1652

DATE MAILED: 07/02/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application N .

09/885,297

Applicant(s)

INGRAM ET AL.

Examiner

Manjunath N Rao

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-110 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-110 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21, 105 drawn to a composition of endoglucanase for degrading oligosaccharide, classified in class 435, subclass 200.
- II. Claims 22-43, 89, 91-96, drawn to a method for degrading oligosaccharide using the endoglucanase, classified in class 435, subclass 277.
- III. Claims 44-59, 97-104, 106-110, drawn to a recombinant host cell suitable for degrading an oligosaccharide, classified in class 435, subclass 252.3.
- IV. Claims 60-65, 90, drawn to a method of enhancing degradation of oligosaccharide, classified in class 435, subclass 262.
- V. Claims 66-74, drawn to a method of making a recombinant host cell suitable for degrading an oligosaccharide, classified in class 435, subclass 471.
- VI. Claims 75-85, drawn to a method of producing ethanol from an oligosaccharide source, classified in class 435, subclass 161.
- VII. Claims 86-88, drawn to vectors comprising a plasmid, host cell, classified in class 435, subclass 320.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, III, VII are products which are patentably distinct from each other. The polypeptide of group I, the host cell of group III, and the polynucleotide of group VII each comprise amino acid sequences and nucleotide sequences which are chemically unrelated, do not require each other for practice; have separate utilities, such as use of the group I polypeptide to

Art Unit: 1652

catalyze a hydrolytic reaction versus the use of polynucleotide in a hybridization reaction and are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search.

Inventions II, IV, V, VI are methods which are patentably distinct from each other. The method of degrading oligosaccharides of group II, the method of enhancing degradation of oligosaccharide of group IV, the method of making a recombinant cell of group V and the method of producing ethanol of group VI are all unrelated as they comprise distinct steps, utilize different products and produce different results. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

Inventions I and II, IV, VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptides of group I can be used to raise specific antibodies as opposed to its use in groups II, IV and VI.

Inventions I and V are patentably distinct from each other. The product of group I is neither used nor made in the method of group V and have separate utilities. They are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

Art Unit: 1652

Inventions III and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the recombinant host cell can be used to make recombinant proteins as opposed to its use in the degradation of oligosaccharides.

Inventions II and VII are patentably distinct from each other. The method of group II neither makes nor uses the product of group VII. The inventions have separate utilities and are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

Inventions III and IV, VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the recombinant host cell can be used to make recombinant proteins as opposed to its use in the methods of groups IV and VI.

Inventions III and V are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be

Art Unit: 1652

made by another and materially different process (MPEP § 806.05(f)). In the instant case the method of making recombinant host cell encoding a endoglucanase polypeptide, by introduction of a heterologous polynucleotide segments into a host cell can be used to make host cells expressing heterologous polypeptides other than endoglucanase.

Invention IV and VII are patentably distinct from each other. The product of group VII is neither made nor used in the method of group IV. They have separate utilities and are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

Inventions VII and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the vectors can be used as probes in a hybridization reaction as opposed to its use of making a host cell as group V.

Invention VI and VII are patentably distinct from each other. The product of group VII is neither made nor used in the method of group VI. They have separate utilities and are subject to separate manufacture and sale. The groups have acquired separate status in the art and separate fields of search as further evidenced by their separate classification.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath N Rao whose telephone number is 703-306-5681. The examiner can normally be reached on 7.30 a.m. to 4.00 p.m..

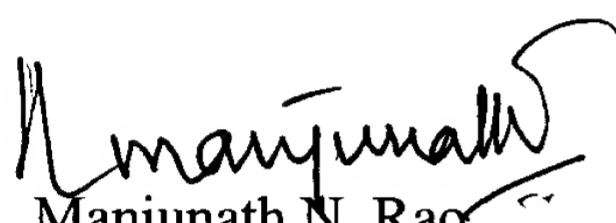
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Application/Control Number: 09/885,297

Page 7

Art Unit: 1652

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0196.

  
Manjunath N. Rao  
June 27, 2002